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REMARKS

In the Office Action dated April 7, 2009, claims 1-20, 38 and 48-50 were considered. The Office Action rejected these claims under 35 U.S.C. §112, second paragraph, and under 35 U.S.C. §§102 and 103.

In the present Amendment, claims 2-4, 8, 9, 11, and 16 have been amended; and claims 1 and 5-7 have been canceled. Claims 2-4, 8-20, 38, and 48-50 are pending. Applicant respectfully submits that no new matter is introduced by the present amendments.

Further, on September 16, 2009, Applicant, by its undersigned counsel, engaged in a telephone interview with Examiner Wollenberger in which the rejections under 35 U.S.C. §112, second paragraph, and §§ 102 and 103 were discussed. Applicant thanks Examiner Wollenberger for his courtesy in conducting this interview.

Claim Objection

The Office Action has objected to Claims 9 and 11 because the claims are missing the word “molecule” after the recitation “said RNAi” in line 2 of the claims. Applicants have amended Claim 9 and 11 to address this objection.

Claim Rejection Under 35 U.S.C. § 112, second paragraph

The Office Action has rejected claim 16 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention (Office Action, p. 3). Specifically, the Office Action indicates that there is insufficient antecedent basis in claim 16 for the recitation “The viral vector of claim 13”. Claim 16 has been amended such that claim 16 depends from claim 14.

Claim Rejection Under 35 U.S.C. § 102(e)

The Office Action has rejected claims 1-12, 14-17, and 38 under 35 U.S.C. § 102(e) as anticipated by Martinez et al. (U.S. Publication No. 2004/0265230 A1; hereafter referred to as “the Martinez ‘230 Publication”)(Office Action, pp. 3-4). Accordingly, Applicants herewith submit a Declaration Under 37 C.F.R. § 1.131 indicating that the inventions of claims 1-12, 14-17, and 38 antedate the Martinez ‘230 Publication. Also, attached to the Declaration Under 37 C.F.R. § 1.131 are documents showing experiments from the laboratory notebook of Nariyoshi Shinomiya, one of the inventors of the present application. The Martinez ‘230 Publication claims an effective filing date of January 6, 2003. Because Applicants have antedated the Martinez ‘230 Publication, Applicants respectfully submit that the reference should not be applied against claims 1-12, 14-17, and 38 of the present application and the rejection based on this reference should be withdrawn.

Claim Rejection Under 35 U.S.C. § 103

The Office Action includes three claim rejections under 35 U.S.C. § 103(a).

Claims 1-3, 8-18, 38, and 48 have been rejected under 35 U.S.C. § 103(a) over Mroczkowski et al. (EP 1 243 596 A2) in view of (i) Abounader et al. (2002) FASEB J. 16(1):108-110, (ii) Tuschl et al. (U.S. Patent Publication No. 2004/0259247 A1), (iii) Elbashir et al. (2002) Methods 26:199-213, (iv) Shi et al. (U.S. Publication No. 2003/0180756 A1), and (v) Kaemmer (U.S. Publication No. 2004/0162255 A1) (Office Action, pp. 5-10). Applicants have canceled claim 1. Because all of the pending claims, except claim 51, depend from claim 4 (which recites the RNAi molecule of SEQ ID NO. 15), Applicants respectfully contend that they have overcome this section 103 rejection as to claims 1-3, 8-18, 38, and 48 and, therefore, this rejection should be withdrawn.

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Claims 19, 20, 49, and 50 have been rejected under 35 U.S.C. § 103(a) over the Martinez '230 Publication (as applied to claims 1-12, 14-17 and 38) in view of Shi et al. and Abounader et al. (Office Action, pp. 10-11). Because the Martinez '230 Publication has been removed as a reference, Applicants respectfully contend that this section 103 rejection should be withdrawn.

Claims 1-20, 38, and 48-50 have been rejected under 35 U.S.C. § 103(a) over Vande Woude et al. (U.S. Publication No. 2007/0020234 A1) in view of (i) the Martinez '230 Publication, (ii) Mroczkowski et al., (iii) Abounader et al., (iv) Tuschl et al., (v) Elbashir et al., (vi) Shi et al., and (vii) Kaemmer (Office Action, pp. 11-13). The Office Action also indicates that the Vande Woude et al. reference constitutes prior art only under 35 U.S.C. § 102(e); and that the rejection might be overcome by showing a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective filing date of the reference under 37 C.F.R. § 1.131 (Office Action, p. 12). The effective filing date of the Vande Woude et al. reference is July 7, 2003. As noted above, Applicants have submitted a Declaration Under 37 C.F.R. § 1.131. This Declaration indicates that the inventions of claims 1-20, 38, and 48-50 antedate Vande Woude et al. Because Applicants have antedated the Vande Woude et al. reference, Applicants respectfully submit that the reference should not be applied against claims 1-20, 38, and 48-50 in the present application and the rejection based on this reference should be withdrawn.

Claim Rejection – Double Patenting

The Office Action has provisionally rejected claims 1-20, 38, and 48-50 on the ground of nonstatutory obviousness-type double patenting over at least claims 9, 10, 22, 30, and 32 of Application No. 10/563,616 in view of the (i) Martinez '230 Publication, (ii) Mroczkowski et al.,

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(iii) Abounader et al., (iv) Tuschl et al., (v) Elbashir et al., (vi) Shi et al., and (vii) Kaemmer (Office Action, pp. 14-15). Because all of the pending claims depend from claim 4 which recites the RNAi molecule of SEQ ID NO. 15, Applicants respectfully contend that this rejection should be withdrawn. Moreover, because the Martinez '230 Publication has been removed as a reference, Applicants respectfully contend that this rejection should be withdrawn.

Rejoinder of Claims 48-50

Claims 48-50 depend from linking claim 38. Accordingly, given that claim 38 now is in condition for allowance, Applicant respectfully requests that claims 48-50 also be allowed.

CONCLUSION

Applicants respectfully request entry of this Amendment and Response, withdrawal of all bases for rejection, and allowance of claims 2-4, 8-20, 38, and 48-50 in due course. The Examiner is invited to telephone Applicants' undersigned representative at (616) 949-9610 to discuss any outstanding issues.

Respectfully submitted,

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Date

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